

Action have been traversed and overcome. Accordingly, reconsideration and withdrawal of the rejection is respectfully requested.

### **STATEMENT OF THE REJECTIONS**

The Examiner has rejected Claims 1-13 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicant regards as the invention.

The Examiner has rejected Claims 1-5 under 35 U.S.C. § 103 as being unpatentable over the background of Piosenka in view of Blonstein. Moreover, the Examiner has rejected Claims 6-7 and 9-11 under 35 U.S.C. § 103 as being unpatentable over the background of Piosenka in view of Schireck. Additionally, the Examiner has rejected Claims 12-13 under 35 U.S.C. § 103 as being unpatentable over Schireck and the background of Piosenka. Furthermore, the Examiner has rejected Claim 8 under 35 U.S.C. § 103 as being unpatentable over the combination of the background of Piosenka and Schireck in view of Blonstein.

### **THE REFERENCES**

Piosenka et al. (Piosenka), U.S. Patent No. 4,993,068, teaches a personal identification system that generates one-way encrypted versions of physically immutable identification credentials which are stored on a portable memory device.

Blonstein et al. (Blonstein), U.S. Patent No. 5,319,724, teaches an apparatus and corresponding method for compressing still images while still compatible with a Joint Photographic Experts Group (JPEG) Transform.

Schireck, U.S. Patent No. 5,306,049, teaches a sports memorabilia authentication kit in which a collectable sports item is marked with an original thumbprint of a sports figure associated with the item and an authentication card having a duplicate original print together with other identifying indicia to identify the sports figure.

### **ARGUMENT**

**Rejection of Claims 1-13 Under 35 U.S.C. § 112**

It is to be noted that Claim 1 has been amended to provide antecedent basis. Also, it is to be noted that Claim 6 has been amended to clearly state the location of comparing step. Accordingly, withdrawal of the rejection is requested.

**Rejection of Claims 1-5 Under 35 U.S.C. § 103**

Claims 1-5 stand rejected under 35 U.S.C. § 103 as being unpatentable over the background of Piosenka in view of Blonstein.

**Claim 1**

The Applicant notes the position of the Examiner that the background of Piosenka discloses a secure identification utilizing physical traits comprising: at least one centralized computer centralized database or repository storing a database of image files; and wherein a plurality of remote terminals in operative communication with the centralized computer and wherein the comparisons are made with at least image files stored in the centralized database (citing col. 1, line 55 to col. 2, line 9).

The Applicant takes the position that such referencing to the background of Piosenka is deficient. After careful review of the background of Piosenka, the Applicant argues that the background thereof is presented in terms too broad and too general for it to sufficiently enable one skilled in the art to practice the invention. Otherwise, in practicing the invention, the result would lead to pure speculation by one skilled in the art because of the absence of a detailed description of the components of the disclosed prior art.

Moreover, in regards to the approach suggested by the Examiner, taking into account the background of Piosenka in view of the detailed description of Piosenka, such combination is impossible because, logically, the detailed description of Piosenka teaches away from the background thereof. In fact, the language in Piosenka explicitly confirms that it teaches away therefrom:

Accordingly, it is an object of the present invention to provide a universally accepted personal identification system providing for low cost

identification of personnel at remote access control points without the need of a large, on-line centralized data base to control each of the remote access control points. (col. 2, line 43-48).

However, even with the broad language cited by the Examiner (col.1, line 55 to col. 2, line 9), it should be recognized that the precise elements of the present invention are easily distinguishable from the cited language. The background of Piosenka provides only a single centralized database, whereas the description of the present invention may include a plurality of central databases. The background of Piosenka states in pertinent part as follows:

Typically, these distributed access control points are linked via a communication medium to a centralized data base. The centralized data base serves as the repository for previously stored physical trait data. . . . (col. 1, line 58-62).

In contrast, the claims of the present invention include at least one centralized database or server and, thus, may comprise of a plurality of centralized databases. The plurality of the centralized databases may be used for one or more of the desired functions, each being connected to at least one remote site.

The background of Piosenka refers only to a single remote site stating that "[a] remote access control point transmits the data representing the physical trait . . . ." (col. 1, line 65-66). However, the present invention provides for "a plurality of remote terminals in operative communication with one or more of the centralized computers . . . ." Thus, dependent on the information conveyed, the present invention allows at least one server to communicate with a number of remote sites.

The Applicant notes the position of the Examiner that Blonstein teaches compression of still images utilizing JPEG. Although it is argued in the Office Action that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the background of Piosenka by incorporating the JPEG still image compressing technique to images as taught by Blonstein, the argument is impracticable.

The Applicant takes the position that the combination of the background of Piosenka and Blonstein would necessitate significant modifications and additions to the background of Piosenka due to the extremely general terms used to describe the background thereof. In order to combine the two references in the manner suggested, the background of Piosenka would first require an addition of a step to incorporate the JPEG still image compressing technique, and a modification of the description in accordance thereof. As shown hereinabove, the background of Piosenka provides only a general description of its prior art. The addition of a step to incorporate the JPEG still image compressing technique to the background of Piosenka and the necessary modifications thereto would be a significant modification to the background of Piosenka, rendering the suggested combination infeasible.

The Applicant also notes the argument of the Examiner that it is considered obvious to one of ordinary skill in the art to provide a comparison means to compare image files at the remote site. However, such argument is irrelevant hereto, due to the overly simplistic language provided by the background of Piosenka in describing the invention. Such use of generality renders the description in the background thereof too broad, necessitating significant modifications as mentioned hereinabove.

In view of the above arguments, Claim 1 should be rendered patentable.

#### Claims 2-5

As to Claims 2-5, Claims 2-5 depend from Claim 1 and include the limitation thereof. For the reasons that Claim 1 is not rendered obvious by the background of Piosenka and Blonstein, neither are Claims 2-5 rendered obvious. Accordingly, withdrawal of the rejection is requested.

#### **Rejection of Claims 6-7 and 9-11 Under 35 U.S.C. § 103**

Claims 6-7 and 9-11 stand rejected under 35 U.S.C. § 103 as being unpatentable over the background of Piosenka in view of Schireck.

#### Claim 6

Regarding Claim 6, the Applicant notes the argument of the Examiner that the background of Piosenka discloses a secure identification method, comprising the steps of: capturing a first graphical representation of a subject at a first data terminal, transferring and receiving the first graphical representation of the subject at a centralized computer and storing the information representative of the subject at the centralized database and receiving a request from a user and inputting a second graphical representation of the subject, downloading, comparing and authenticating (citing col. 1, line 55 to col. 2, line 9).

However, such cited broad language of Piosenka is absent the precise elements of Claim 6. The background of Piosenka fails to specifically provide a first data terminal from which a first graphical representation of a subject is captured, wherein the first data terminal is distinguishable from a second data terminal.

Unlike the description of the present invention, the background of Piosenka fails to specifically state the manner in which data is transferred and stored into the centralized database system. On the other hand, Claim 6 of the present invention fully and clearly states that data is transferred and stored into the centralized database system.

In addition, the background of Piosenka further fails to specifically describe that a user at a second data terminal performs a request requiring authentication. However, the disclosure of the present invention provides that a request requiring authentication at a second data terminal.

Moreover, the background of Piosenka also is absent any particular description of inputting a second graphical representation of the subject, downloading, comparing and authenticating. On the other hand, the present invention provides a more specific description of inputting a second graphical representation of the subject, downloading, comparing and authenticating. A quick review of the pertinent parts of the steps of the Claim 6 clearly provides a more specific elaboration than that of the background of Piosenka:

inputting, at the second data terminal, a second graphical representation of the subject;  
downloading, from the centralized computer, information representative of the previously stored first graphical representation of the subject;  
comparing, at the location of the second data terminal, the first and second graphical representation of the subject; and  
authenticating the user if the first and second graphical representations of the subject are substantially the same. (Claim 6 AMENDED).

In particular, the location of the comparison of traits of the present invention is distinguishable from the location of the comparison of traits of the background of Piosenka. The background of Piosenka provides that the comparison of traits is performed at the centralized database. "The central repository then matches the data obtained from the remote access control point with the prestored data retrieved from the data base." (col. 1, line 68 to col. 2, line 3). However, the present invention provides that the comparison of traits is performed at the remote site. For example, Claim 6 states, "[C]omparing, at the location of the first data terminal, the first and second graphical representations of the subject. . . . (Claim 6).

It is stated in the Office Action that Schireck teaches utilization of a relational database to store digitized images, and that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the background of Piosenka as taught by Schireck in order to provide a more sophisticated means of tracking and recording the authentication of digitized files as taught by Schireck (citing col. 2, line 66 to col. 3, line 5).

The Applicant takes the position that, although Schireck may or may not teach utilization of a relational database to store digitized images, the combination of the background of Piosenka and Schireck would necessitate significant modifications and additions to the background of Piosenka due to the extremely general terms used to describe the background thereof. In order to combine the two references in the manner suggested, the background of Piosenka would first require an addition of a means of tracking and recording the authentication of files, and a modification of the description in

accordance thereof. The background of Piosenka only generally states that "[t]he central repository then matches the data obtained from the remote access control point with the prestored data retrieved from the data base." (col.1, line 68 to col. 2, line 3). The addition of the means of tracking and recording would be a significant modification to the background of Piosenka, rendering the suggested combination infeasible.

The Applicant notes the argument in the Office Action that it is considered an obvious design choice to provide a means to compare and do comparisons at remote sites, due to the advantage of alleviating the central computer from performing comparisons. However, such argument is irrelevant hereto, due to the overly simplistic language provided by the background of Piosenka in describing the invention. Such use of generality renders the description in the background thereof too broad, necessitating significant modifications as mentioned hereinabove.

In addition, the background of Piosenka and Schireck do not contain any suggestion, expressed or implied, that they be combined, or that they be combined in the manner suggested. In fact, the only suggestion of such a combination is the present application. Such suggestion would be reconstructive hindsight and, thus, legal error.

#### Claim 7

At the outset, it is to be noted that Claim 7 has been amended to state that second data terminal is the first data terminal. This is nowhere shown by the cited references and further defines and establishes the patentability of the present invention.

#### Claim 9

As to Claim 9, Claim 9 depends from Claim 6. For the reasons that Claim 6 is not rendered obvious by the background of Piosenka in view of Schireck, neither is Claim 9 rendered obvious by the background of Piosenka in view of Schireck.

#### Claim 10

As to Claim 10, Claim 10 depends from Claim 6. For the reasons that Claim 6 is not rendered obvious by the background of Piosenka and Schireck, neither is Claim 10 rendered obvious.

#### Claim 11

At the outset, it is to be noted that Claim 11 has been amended to more clearly define the subject.

#### **Rejection of Claims 12-13 Under 35 U.S.C. § 103**

Claims 12 and 13 stand rejected under 35 U.S.C. § 103 as being unpatentable over the background of Piosenka and Schireck.

#### Claims 12 and 13

As to Claims 12 and 13, Claims 12 and 13 depend from Claim 6. For the reasons that Claim 6 is not rendered obvious by the background of Piosenka in view of Schireck, neither are Claims 12 and 13 rendered obvious by the background of Piosenka in view of Schireck.

However, in arguendo, the Applicant notes the argument in the Office Action that it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the combination of the background of Piosenka and Schireck by providing the remote terminals with a means to store the database of subject graphical representations. The combination of the background of Piosenka and Schireck would necessitate significant modifications and additions to the background of Piosenka due to the extremely general terms used to describe the background thereof. In order to combine the two references in the manner suggested, the background of Piosenka would first require an addition of a means to store the database of subject graphical representations at the remote terminals, and a modification of the description in accordance thereof. The background of Piosenka only generally states that "[t]he centralized data base serves as the repository for previously stored physical trait data. . . ." (col.1, line 60-62). The addition of the means to store the database of subject graphical representations at the



remote terminals would be a significant modification to the background of Piosenka, rendering the suggested combination infeasible.

In arguendo, the Applicant notes the argument of the Examiner that it is considered obvious to one of ordinary skill in the art at the time of the invention to encrypt database information of the plurality of remote data terminals. However, such argument is irrelevant hereto, due to the overly simplistic language provided by the background of Piosenka in describing the invention. Such use of generality renders the description in the background thereof too broad and the suggested combination impracticable.

#### **Rejection of Claim 8 Under 35 U.S.C. § 103**

Claim 8 stands rejected under 35 U.S.C. § 103 as being unpatentable over the background of Piosenka and Schireck in view of Blonstein.

As to Claim 8, Claim 8 depends from Claim 6. For the reasons that Claim 6 is not rendered obvious by the background of Piosenka in view of Schireck, neither is Claim 8 rendered obvious by the background of Piosenka in view of Schireck and Blonstein.

The combination of the background of Piosenka, Schireck, and Blonstein would necessitate significant modifications and additions to the background of Piosenka due to the extremely general terms used to describe the background thereof. In order to combine the three references in the manner suggested, the background of Piosenka would first require an additional step of incorporating the JPEG still image compressing technique, and a modification of the description in accordance thereof. The background of Piosenka provides only a general description of its prior art. The additions and modifications would be an extremely significant modification to the background of Piosenka, rendering the suggested combination infeasible.

In addition, the background of Piosenka, Blonstein, and Schireck do not contain any suggestion, expressed or implied, that they be combined, or that they be combined in the manner suggested. In fact, the only suggestion of such a combination is the present application. Such suggestion would be reconstructive hindsight and, thus, legal error.

Therefore, in summary, the Applicant respectfully submits that he has traversed and overcome all bases of rejection by the present amendment. He has amended the claims to render them distinct from the art of record and to clearly articulate the claimed invention(s). Thus, he submits that in the absence of more pertinent art, he has place the application in condition for allowance. He, therefore, respectfully requests a notice to this effect.

If the Examiner feels that the prosecution of this application can be expedited then he is courteously requested to place a telephone call to Applicant's Attorney at the number listed below.

Respectfully submitted,



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